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MAILED

JAN 20 2012

OFFICE OF PETITIONS

In re Application of :
Jungbluth, et al. :
Application No. 10/579,655 : **DECISION**
Filed/Deposited: 10 August, 2007 :
Attorney Docket No. API-03-15-US :

This is a decision on the petition filed on 5 October, 2011, pursuant to 37 C.F.R. §1.137(b) for revival of an application abandoned due to unintentional delay.

NOTE:

Following what the Office found to be Petitioner's failure to reply timely and properly in the instant application to a Notice on 25 May, 2011, the Office mailed a Notice of Abandonment on 28 June, 2011.

Petitioner apparently chose not to reply timely to the 28 June, 2011, Notice of Abandonment—*e.g.*, to seek relief pursuant to 37 C.F.R. §1.181.

Rather, on 16 September, 2011, and again on 19 September, 2011, Petitioner replied to the Notice of 25 May, 2011, with a submission and then a "supplement," respectively.

The application remained abandoned and Petitioner took no action at that time to alter that state.

On 5 October, 2011, Petitioner:

- filed a petition pursuant to 37 C.F.R. §1.137(b) to revive the application and a fee for the petition;
- also filed a request for a refund of the fee because Petitioner felt the abandonment was not proper—and the Office replied with a refund on 6 October, 2011.

At no time within two months of the 28 June, 2011, Notice of Abandonment did Petitioner properly seek relief pursuant to 37 C.F.R. §1.181.

The instant petition pursuant to 37 C.F.R. §1.137(b) is present in the record, however, it is present without a fee because Petitioner insisted upon having the fee refunded.

The Office cannot and will not address such a petition substantively in the absence of the fee.

The petition pursuant to 37 C.F.R. §1.137(b) is **DISMISSED**.

Any request for reconsideration of this decision or any petition in the alternative is to be filed **within two (2) months** from the mail date of this decision. *Note* 37 C.F.R. §1.181(f). The request for reconsideration should include a cover letter and be entitled as a “Renewed Petition under 37 C.F.R. §1.181 to Withdraw the Holding of Abandonment,” and/or “Renewed Petition under 37 C.F.R. §1.137(b).”

This is **not** a final agency action within the meaning of 5 U.S.C. §704.

**As to the Allegations
of Unintentional Delay**

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee.

Petitioner does not appear to have addressed properly the requirements under the rule (e.g., fees).

Any deficiencies must be overcome.

BACKGROUND

The record reflects as follows:

The Examiner mailed requirements for sequence disclosures on 27 November, 2009, and 23 June, 2010, to which Petitioner filed replies on 27 April, 2010, and 25 October, 2010, respectively, however the record also evidences that neither reply was proper.

Thereafter, Petitioner failed to reply timely and properly to the Examiner’s third Notice as to sequence disclosures mailed on 25 May, 2011, with reply due absent extension of time on or before 25 June, 2011.

(Petitioner appears to have filed a set of papers on 20 June, 2011, however, that was the third in Petitioner's series of submissions, and again the Examiner found that the reply was not proper.)

On 28 June, 2011, the Office mailed a Notice of Abandonment.

Petitioner did not reply to the 28 June, 2011, Notice.

Rather, on 16 September, 2011, and then on 19 September, 2011, Petitioner replied to the Notice of 25 May, 2011, with a submission and then a "supplement," respectively, with a request and fee for extension of time.

However, the application remained abandoned pursuant to the 28 June, 2011, Notice, and Petitioner took no action to alter that state.

On 5 October, 2011, Petitioner:

- filed a petition pursuant to 37 C.F.R. §1.137(b) to revive the application and a fee for the petition;
- also filed a request for a refund of the fee because Petitioner apparently considered the abandonment not proper—and the Office replied with a refund on 6 October, 2011.

At no time within two months of the 28 June, 2011, Notice of Abandonment did Petitioner properly seek relief pursuant to 37 C.F.R. §1.181. Thereafter, Petitioner no longer had the right to call upon that provision of the Rules of Practice for relief.

(The Rules of Practice¹ and the guidance in Commentary in the Manual of Patent Examining Procedure (MPEP)² provide protections and benefits for applicants and practitioners, however, those protections and benefits are unavailable when those rules and guidance are not complied with/followed.)

The instant petition pursuant to 37 C.F.R. §1.137(b) is present in the record without a fee, and the Office cannot and will not address such a petition substantively in the absence of the fee.

Thus, Petitioner failed to comply with the requirements under the Rule.

Petitioner is cautioned that the failure to timely and properly remedy any deficiencies herein—including those as to the petition fee—may be considered indicia of delay that is other than unintentional.

¹ See: 37 C.F.R.: <http://www.uspto.gov/web/offices/pac/mpep/documents/appxr.htm>.

² See: MPEP: <http://www.uspto.gov/web/offices/pac/mpep/index.htm>.

Petitioners' attentions always are directed to the guidance in the Commentary at MPEP §711.03(c) as to the showing regarding unintentional delay and a petition pursuant to 37 C.F.R. §1.137(b).

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office **must** inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.³

STATUTES, REGULATIONS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994). And the regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application.^{4, 5}

Moreover, the Office has set forth in the Commentary at MPEP §711.03(c)(I) the showing and timeliness requirements for a proper showing for relief under 37 C.F.R. §1.181 in these matters.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits

³ See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §11.18, formerly §10.18, to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

⁴ See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁵ The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition. (Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.) Delays in responding properly raise the question whether delays are unavoidable. Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a). And the Petitioner must be diligent in attending to the matter. Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care. (By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.))

them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.⁶

As to Allegations of
Unintentional Delay

As indicated above, the requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a proper reply, a proper statement and/or showing of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee.

As discussed above, it does not appear that Petitioner has satisfied the requirements under the rule.

Petitioners' attentions always are directed to the guidance in the Commentary at MPEP §711.03(c)(II) as to a petition pursuant to 37 C.F.R. §1.137.

CONCLUSION

Accordingly, the petition pursuant to 37 C.F.R. §1.137(b) is dismissed.

Further correspondence with respect to this matter should be addressed as follows:


By Mail: Mail Stop PETITION
 Commissioner for Patents
 P. O. Box 1450
 Alexandria, VA 22313-1450

By hand: U. S. Patent and Trademark Office
 Customer Service Window, Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

⁶ *In re Mattullath*, 38 App. D.C. 497, 514-15 (1912)(quoting *Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also *Winkler v. Ladd*, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), *aff'd*, 143 USPQ 172 (D.C. Cir. 1963); *Ex parte Henrich*, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." *Haines v. Quigg*, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

By facsimile: (571) 273-8300
Attn: Office of Petitions

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2⁷) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

⁷ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.